



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,497	08/09/2001	Leonid Ivanovich Akopov	GAI-001US	2241

21125 7590 08/24/2005

NUTTER MCCLENNEN & FISH LLP
WORLD TRADE CENTER WEST
155 SEAPORT BOULEVARD
BOSTON, MA 02210-2604

EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
----------	--------------

3739

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,497

Applicant(s)

AKOPOV ET AL.

Examiner

david shay

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 2, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date March 28, 2002.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

The indicated allowability of claims 1-26 is withdrawn in view of the newly discovered reference(s) to Lundahl et al. Rejections based on the newly cited reference(s) follow.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure does not enablingly describe how to construct a "patient pain threshold sensor".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-11, 14-18, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9-11 are indefinite as it is unclear exactly what arrangement of reflector halves and dielectric halves is intended to be claimed as applicant appears to be requiring the device be constructed such that the tissue is to be contained inside the device housing. Art cannot be meaningfully applied to these claims. Claims 14-18 are indefinite as the use of the subjunctive

Art Unit: 3739

“may” does not actually require that the recited structures be present. In claim 22, it is unclear exactly what is being claimed, specifically, exactly where the “cubical transparent dielectric” is located is unclear; this claim also positively recites the body. Art cannot be meaningfully applied to this claim.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1, 14-18, 21, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundahl et al in combination with Gates, Jr. Lundahl et al teach a light applying device with a reflector and which requires a high degree of precision in the output spectrum, among other things (see column 4, lines 15-25). Gates, Jr. teaches a device as claimed in claim 1, except for the reflector with a mirror surface. It would have been obvious to the artisan or ordinary skill to employ lamp of Gates, Jr. in the device of Lundahl et al since Lundahl et al requires high precision, and teach that alternate lighting technologies can be used, to situate the lamp the claimed distance of lamp diameters from the waveguide, since this is not critical and provides no unexpected result, and is thus merely a matter of design choice; and to employ a power supply including a battery, since this is notorious in the art, official notice of which is hereby taken, thus producing a device and method such as claimed.

Claims 2-5, 7, 8, 13, 19, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundahl et al in combination with Gates, Jr. as applied to claim 1 above, and

Art Unit: 3739

further in combination with Eckhouse. Eckhouse teaches the use of filters to control the output spectrum of a treatment device and a conical fiber input tip (see Figure 4). It would have been obvious to the artisan of ordinary skill to provide the filter and fiber tip of Eckhouse in the combined device of Lundahl et al in combination with Gates, Jr. since this would enable the further control of the output spectrum and greater power transfer, respectively; to employ the claimed cone angle of the fiber, since this produces no unexpected result; to employ a metal mount and water of -1 to -18 degrees celcius, since the metal would increase heat transfer, as is well known in the art, and it is notorious in the art to control the coolant temperature to produce a desired surface temperature, given the amount of energy incident on the tissue, official notice of which is hereby taken; and to employ the various types of filters claimed, since these are not critical, are notorious filters in the art, and provide no unexpected result, thus producing a device such as claimed.

Claims 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundahl et al in combination with Gates, Jr. as applied to claim 1 above, and further in combination with Gustafsson. Gustafsson teaches the use of filters of the form of claim 6. It would have been obvious to the artisan of ordinary skill to provide the filter construction of Gustafsson in the combined device of Lundahl et al in combination with Gates, Jr. since this would enable the further control of the output spectrum, thus producing a device such as claimed.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak, can be reached on Monday, Tuesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330